



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,164	05/24/2001	Jens Hake	04851/	4082

7590 12/02/2004

John M Harrinton Esq
Kilpatrick Stockton LLP
1001 West Fourth Street
Winston -Salem, NC 27101-2400

EXAMINER

BEAMER, TEMICA M

ART UNIT	PAPER NUMBER
2681	

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/786,164	Applicant(s) HAKE ET AL.	
	Examiner Temica M. Beamer	Art Unit 2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6 and 8 is/are rejected. ✓
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-3, 6 and 8 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 3, 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohashi et al (Ohashi), U.S. Patent No. 5,596,641 discloses.

Regarding claim 1, Ohashi discloses a procedure for the increased security of authentication processes in digital mobile radio systems comprising storing several different secret SIM-specific keys in a mobile radio network and in a subscriber identification module (SIM); pre-configuring and storing a RAND/SRES/KC authentication triplet for each one of the several keys stored in the mobile radio network; selecting and sending a random value RAND of one of the pre-configured authentication triplets to the SIM by the mobile radio network; selecting one of the secret keys stored in the SIM and calculating from the RAND and the selected one of the secret keys a corresponding value for a signed response SRES and cipher key and

Art Unit: 2681

sending the calculated values to the mobile radio network by the SIM and comparing the SRES to all SRES values for the RAND by the mobile radio network and validating the subscriber's authentication if a match is found (col. 8, line 43-col. 9, line 67, col. 10, line 63-col. 11, line 29 and col. 14, lines 16-24).

Regarding claim 2, Ohashi discloses the procedure according to claim 1 further comprising randomly selecting said one of the secret keys stored in the SIM by the SIM (col. 9, lines 15-47).

Regarding claim 3, Ohashi discloses the procedure of claim 1 wherein pre-configuring and storing said RAND/SRES/KC authentication triplet for each of said several different secret keys further comprises passing a RAND and each of said secret key through a plurality of pre-determined algorithms to determine a SRES/KC pair for each of the SIM-specific keys forming with the respective RAND/SRES/KC triplets (col. 2, lines 26-34, col. 3, lines 13-21, col. 6, lines 1-28).

Regarding claim 6, Ohashi discloses the procedure according to claim 3 wherein the SIM calculates the corresponding values for SRES and cipher key from the transmitted RAND and the selected key using its copies of the pre-determined algorithms and sends the determined answer to the mobile radio network (col. 8, line 56-col. 9, line 38).

Regarding claim 8, Ohashi discloses the procedure according to claim 7 is characterized further comprising encrypting a transmission by the mobile radio network and the SIM using the cipher key (col. 2, lines 35-49).

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

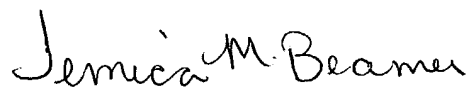
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Beamer whose telephone number is (703) 306-5837. The examiner can normally be reached on Monday-Thursday (alternate Fridays) 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on (703) 308-4825. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2681

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Temica M. Beamer
Examiner
Art Unit 2681

November 29, 2004


ERIKA A. GAFY
PRIMARY EXAMINER